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09/804,385	03/12/2001	Edwin George Watson	EGW-001	1037

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EDWIN G. WATSON  
901 NEW YORK AVE.  
CHERRY HILL, NJ 08002

EXAMINER

CHUONG, TRUC T

ART UNIT PAPER NUMBER

2179

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/804,385

Applicant(s)

WATSON, EDWIN GEORGE

Examiner

Truc T. Chuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-36 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-36 and 41-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This communication is responsive to Amendment, filed 08/30/05.

Claims 21-36, and 41-44 are pending in this application. Claims 21-23, 30, and 41 are independent claims. This action is made final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

### ***Claim Rejections - 35 USC § 102***

1. Claims 21-28, 30-35, and 41-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Simonson (U.S. Patent No. 6,803,930 B1).

As to claim 21, Simonson teaches a method of displaying data in an information display system having a display area, a processor, and at least one displayable data set for displaying on said display area, where said displayable data set is larger than said display area, comprising the steps of:

- determining the display status of said displayable data set, said status includes noting whether or not any portions of said data set have been displayed at least once, in at least one section of said display area, whereby display status is determined by reviewing said displayable data set for which displayed data has been displayed at least once, in at least one section of the display area, as compared to undisplayed data which has not been previously displayed (a virtual indication within or adjacent to the displayed content distinguishing the first and second content portions, e.g., col. 4 lines 23-32, col. 5 lines 20-27, and figs. 7, 8, 12a);

- during data display, marking said-displayed data, to appear visually different according to said display status, whereby said display status, whereby said displayed data is marked base on the determined display status, to visually differentiate on screen said data which has been displayed at least once, in at least one section of a display screen, from data which has not been previously displayed, and is newly displayed data as a result of a display command (e.g., col. 7 lines 1-30, and command, col. 7 lines 35-45).

As to claim 22, this is a system claim of method claim 21. Note the rejection of claim 21 above.

As to claim 23, Simonson teaches a method of displaying data in an information display system having a display area, a processor, and at least one displayable data set for displaying on said display area, said displayable data set having dimensions larger than said display area comprising the steps of:

- determining the display status of said displayable data set, said status includes noting whether or not my portions of said data set have been displayed at least once in at least one section of said display area, whereby display status is determined by reviewing said displayable data set for which displayed data has been displayed at least once, in at least one section of the display area, as compared to undisplayed data which has not been previously displayed (e.g., col. 4 lines 23-32, col. 5 lines 20-27, col. 7 lines 1-30, and figs. 7, 8, 12a);
- during the process of displaying at least a portion of said displayable data set in said display area marking said displayed data to appear visually different

according to said display status, whereby said displayed data is marked based on the determined of display status, to visually differentiate on screen said data which has been displayed at least once in at least one section of the display area from data which has not been previously displayed, and is newly displayed data as a result of a display command (e.g., col. 7 lines 1-30, and command, col. 7 lines 35-45);

- repeating the steps of determining display status of said displayable data set and marking said displayed data according to said displayed status for any subsequent displaying of data (the size of such a directional artifact might indicate the relative distance to the previous portion, such that a small arrow might indicate a nearby portion, and a large arrow might indicate a distant portion, e.g., col. 9 lines 5-32), whereby each time a display area change occurs, the display status of said displayable data set is re-determined, and in turn, said marking of said displayed data based on said re-determined display status is also updated (fig.9 shows the steps repeatedly provide visual differentiation between previously viewed and newly presented content, e.g., col. 7 line 35-col. 8 line 9).

As to claim 24, Simonson teaches the method according to claim 23, wherein the step of marking further includes shading over said displayed data (changing in size, brightness, color, highlight, e.g., col. 9 lines 24-53, and figs. 12a and 13b).

As to claim 25, Simonson teaches the method according to claim 23, wherein the step of marking further includes spacing changes between displayed data said visual difference is

achieved by displaying data with changed spacing between elements (changing in size, it can be discussed under similar rationale as claim 24 above).

As to claim 26, Simonson teaches the-method according to claim 23, wherein the step of marking further includes varying the persistence or time that said marking is displayed whereby said marking can fade away from said display area after a certain amount of elapsed display time or otherwise commanded to do so (artifacts might fade over time, so that they are less likely to disturb users reading the document, e.g., col. 9 lines 25-32, col. 10 lines 1-7, and col. 11 lines 31-35).

As to claim 27, Simonson teaches the method according to claim 23, wherein the step of marking further includes outlining or framing of displayed data (indicate the boundary, e.g., col. 7 lines 15-25, and fig. 7).

As to claim 28, Simonson teaches the method according to claim 23, wherein the step of marking further includes converting marked data to selected data for use in an editing system the results of said display status marking can be converted to selected data in conjunction with an editing system (the techniques described here can be implemented to be selectable as user preferences. For example, the user could choose from a selection of options corresponding to each of the techniques supported by the application. The user could then select those options that improve his ability to use the application to view and modify the content, e.g., col. 10 lines 50-64, and col. 11 lines 38-44).

As to claims 30-35, they are system claims of method claims 23-28. Note the rejections of claims 23-28 above respectively.

As to claim 41, Simonson teaches a method of displaying data in an information display system having a display area, and a processor, comprising the steps of:

- providing at least one displayable data set to be displayed on said display area, said displayable data set having dimensions larger than said display area (fig. 7 shows a scroll bar to view a larger document than the viewer window, e.g., col. 5 lines 61-62);
- displaying a first section of the data set on said display area (figs. 12a and 13b);
- marking said first section of data (figs. 7, 12a and 13b);
- displaying a second section of the data set on said display area (figs. 7, 12a and 13b).

As to claim 42, Simonson teaches the method according to claim 41 wherein said second section is further comprised of at least a part of said first section and unmarked data, said first section is marked to appear different from said unmarked data (e.g., col. 9 line 52-col. 10 line 8, and figs. 12a-12b).

As to claims 43-44, they are system claims of method claims 41-42. Note the rejections of claims 41-42 above.

### ***Claim Rejections - 35 USC § 103***

2. Claims 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simonson (U.S. Patent No. 6,803,930 B1) in view of Gerace (U.S. Patent No. 5,848,396).

As to claim 29, Simonson teaches the method according to claim 23, comprising the display process, which sections of said data that were displayed, which sections of said data that were not displayed, elapsed time said sections of said data were displayed, number of times said sections of data were displayed (see the rejections of claims above); however, Simonson does not

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teach a step of collecting and processing statistics from those steps above for summarization or restart purposes. Gerace clearly teaches a user profile/history to keep track with viewing habits of the user (e.g., col. 2 lines 10-15, lines 36-67, and col. 3 lines 11-20). It would have been obvious at the time of the invention, a person with ordinary skill in the art would want to be able to have the user profile of Gerace in the virtual displayed indicator of Simonson to generate and display appropriate screen views to the users (e.g., col. 4 lines 53-55).

As to claim 36, this is a system claim of claim 29. Note the rejection of claim 29 above.

### *Response to Arguments*

3. The Declaration filed on 08/30/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the applied references.

### **Diligence**

Per MPEP 2138.06,

**THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES**

An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 834, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (**statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading**). **A 2-day period lacking activity has been held to be fatal.** In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Or. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ



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530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (**Diligence requires that applicants must be specific as to dates and facts.**).

**The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.** Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (**Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field**); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and **daily job demands**, and held lack of university funding and personnel **are not acceptable excuses.**); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify

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interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) (Activity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course ....").

The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. **Six days to execute and file application is acceptable.** *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Koltonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. **Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.** Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

**In response to the Diligence (pages 5-6 of the Affidavit filed 08/30/05), for example:**

Per (a)-(b), performing multiple searches for prior art at the Library and on-line web do not consider as actual reduction to practice in the case; and the applicant did not provide specific dates and facts to establish diligence from a date prior to the date of reduction to practice of the Simonson reference (December 16, 1999) (i.e., the specific dates and time records (i.e., sign in/out records at the Library, and what document were searched and studied) need to be provided).

Per (c) and (f), spending time of self-teaching to understand how to draft and the procedure for filing a patent application do not consider as evidences to establish diligence.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Simonson reference (December 16, 1999) to the US filing date of this application (March 12, 2001) because applicant merely provide blank statements to support diligence between December 16, 1999 and March 12, 2001, without being specific as to dates and facts.

4. Applicant's arguments filed in an Amendment have been fully considered but they are not persuasive.

Applicants argued and Examiner disagrees for the following reasons:

*a. Simonson makes no reference and the procedure to determining status of the display.*

Simonson clearly teaches the techniques described here allow applications (computer programs) to use a visual indication within the displayed content to

differentiate between previously viewed content and newly presented content, and there are three primary approaches using the applications to differentiating between the previously viewed and newly presented content. First, the application can add or modify an artifact in the display to indicate the boundary. For example, a line or a marker at the point can be inserted where the new content begins or next to the content. Second, the background of the previously viewed or newly presented content could be modified. Third, the content itself, or foreground, could be modified. Examples of possible implementations are described below. In addition, various combinations of these three approaches are possible. FIG. 9, for example, shows a combination of approach one (artifact added) and approach two (background modified) (e.g., col. 7 lines 1-9 and lines 21-34).

*b. Simonson does not demonstrate that marking is performed based on pre-determining display status (must be performed before any visible marking can occur).*

Simonson teaches that artifacts can be made active by allowing the user to select the artifact to take some predetermined or user-specified action. For example, the user might click on the directional artifacts described above in order to return to the previous portion of content. In this case, the artifacts would function essentially like the "Previous" button on many web browsers. For another example, the artifact might operate to perform a relevant command, such as the "Find next match" command available in many word processing programs (col. 9 lines 14-23). It clearly means that the user can predetermine the next action to show the next display status by selecting some of the commands.

- c. Simonson does not show specific description or words describing a repetition of the process.*

Fig. 9 clearly shows that the steps repeatedly visual differentiation between previously viewed and newly presented content (e.g., col. 7 line 35-col. 8 line 9).

- d. Simonson makes no reference to changing spacing between displayed data.*

Simonson teaches the visual indication may include a modification to a foreground of the first portion of content, the second portion of content, or both portions of content. The foreground modification may include an alteration in brightness, hue pattern, font characteristics, graphics characteristics (e.g., col. 5 lines 28-38), and changing in different sizes between previous and current display portions by changing the font sizes can cause different spacing between the display sections.

- e. Simonson makes no reference to converting marked data to selected data for use in a word processing system.*

Simonson teaches content may include a modification of the body of content. The modification of the body of content may include a cut-and-paste operation, an alteration of the appearance of the content or of the window in which the content is displayed, or an addition or deletion of newly presented content to the body of content. The user can select/cut either of the previous or current display to different places/applications for editing or other purposes (e.g., col. 5 lines 40-46), and the techniques described here can be implemented to be selectable as user preferences. For example, the user could choose from a selection of options

corresponding to each of the techniques supported by the application. The user could then select those options that improve his ability to use the application to view and modify the content (e.g., col. 10 lines 50-64, and col. 11 lines 38-44).

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T. Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

11/28/05



WEILUN LO  
SUPERVISORY PATENT EXAMINER